

REMARKS

The present application has been carefully studied and amended in view of the outstanding Office Action dated September 3, 2008, and reconsideration of that Action is requested in view of the following comments.

Applicants respectfully submit that the invention specifically recited in claim 4 and remaining dependent claims 5-9 is neither disclosed nor suggested by the prior art taken alone or in combination with one another. Specifically, claims 4-9 are not rendered obvious by the combination of Hoshino et al US 6,804,300 ("Hoshino") and Shu et al US 6,598,100 ("Shu"), for the following reason.

It is well established that the Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Also, the Examiner must identify a rationale that would have led an ordinarily skilled artisan to combine selected features from each of the applied references in a way that would have resulted in an electronic image frame corresponding to the claimed image frame of the present invention. See *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007). In this regard, the rejection based on § 103(a) must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. See *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

In the rejection of claims 4-9, the Examiner correctly concludes that Hoshino does not disclose the multimedia player as specifically recited in claims 4-9. Although Shu includes disclosure of a multimedia player for playing multimedia files and outputting the video and audio signals in analog format, applicants respectfully disagree with the Examiner's conclusion that the combination of Hoshino and Shu renders obvious the invention of claims 4-9. Such disagreement is based on the following reasons.

The Examiner considers the video inputs 11 and 12 of Hoshino as a teaching or suggestion that such inputs can be connected to an external video or audio source. However, the fact that the video inputs 11 and 12 can be so connected is not the test, and there is no teaching that an ordinarily skilled artisan would actually incorporate a multimedia rendering function in a television apparatus upon reading of the Hoshino and Shu references. Applicants' position is that there is no teaching or suggestion in Hoshino which would inspire or otherwise lead the skilled artisan to render multimedia information in a television receiver, e.g., Hoshino's television audiovisual apparatus.

Additionally, the examiner erroneously concludes that a similar control button set for controlling the operation of the video or audio signal provides another suggestion for the combination of Hoshino and Shu. However, such control button set can be found in a variety of button apparatus, and the issue comes down to why would the skilled artisan select Shu's multimedia player from among such a variety of apparatus. The Examiner fails to provide any reasonable explanation on this point, and as a result his position is not well founded.

For these reasons, applicants respectfully submit that the rejection of claims 4 and dependent claims 5-9 should be withdrawn.

With specific reference to dependent claims 5-9, these claims define preferred features of the present invention unsuggested by the prior art. However, applicants primarily rely upon the novelty and nonobviousness of claim 4 from which claims 5-9 depend either, directly or indirectly.

For at least the above reasons, applicants respectfully request (1) withdrawal of the rejection and (2) allowance of claims 4-9.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 13836-00003-US from which the undersigned is authorized to draw.

Respectfully submitted,

By Richard M. Beck
Richard M. Beck
Registration No.: 22,580
CONNOLLY BOVE LODGE & HUTZ LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, Delaware 19899
(302) 658-9141
(302) 658-5614 (Fax)
Attorneys for Applicants

633657_1.DOC